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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,128	10/30/2000	William J. Flanagan	ET00-008CIP	8743

7590 12/16/2002  
Maureen Stretch  
26 Charles Street  
Natick, MA 01760

EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 12/16/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/702,128

Applicant(s)

FLANAGAN ET AL.

Examiner

Susanna M. Diaz

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This Non-Final Office action is responsive to Applicant's Preliminary Amendment filed October 30, 2000.

Claim 1 has been cancelled.

Claims 1-30 have been added; however, since claim 1 was already cancelled by the Applicant, claims 1-30 have been renumbered as claims 2-31 respectively (under 37 C.F.R. § 1.126).

### *Claim Objections*

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 1-30 have been renumbered 2-31, respectively. **Please make reference to the claims in their renumbered format and adjust the claim dependencies appropriately.** For examination purposes, the following dependencies have been assumed:

Claim 2 (formerly claim 1) is independent.

Claim 3 (formerly claim 2) is dependent from claim 2.

Claim 4 (formerly claim 3) is dependent from claim 3.

Claim 5 (formerly claim 4) is dependent from claim 3.

Claim 6 (formerly claim 5) is dependent from claim 5.

Claim 7 (formerly claim 6) is dependent from claim 3.

Claim 8 (formerly claim 7) is dependent from claim 3.

Claim 9 (formerly claim 8) is dependent from claim 3.

Claim 10 (formerly claim 9) is dependent from claim 6.

Claim 11 (formerly claim 10) is dependent from claim 10.

Claim 12 (formerly claim 11) is dependent from claim 10.

Claim 13 (formerly claim 12) is dependent from claim 3.

Claim 14 (formerly claim 13) is dependent from claim 2.

Claim 15 (formerly claim 14) is dependent from claim 14.

Claim 16 (formerly claim 15) is dependent from claim 12.

Claim 17 (formerly claim 16) is independent.

Claim 18 (formerly claim 17) is dependent from claim 17.

Claim 19 (formerly claim 18) is dependent from claim 18.

Claim 20 (formerly claim 19) is dependent from claim 18.

Claim 21 (formerly claim 20) is dependent from claim 20.

Claim 22 (formerly claim 21) is dependent from claim 18.

Claim 23 (formerly claim 22) is dependent from claim 18.

Claim 24 (formerly claim 23) is dependent from claim 18.

Claim 25 (formerly claim 24) is dependent from claim 21.

Claim 26 (formerly claim 25) is dependent from claim 25.

Claim 27 (formerly claim 26) is dependent from claim 25.

Claim 28 (formerly claim 27) is dependent from claim 18.

Claim 29 (formerly claim 28) is dependent from claim 18.

Claim 30 (formerly claim 29) is dependent from claim 29.

Claim 31 (formerly claim 30) is dependent from claim 27.

### ***Specification***

3. The disclosure is objected to because of the following informalities:

On page 1 of the specification, please amend the continuing data under 35 U.S.C. § 120 to include the present status of each parent case (e.g., "now U.S. Patent No. \_\_\_\_\_").

Page 38, line 8: There is no Fig. 15c-3; therefore, please delete the reference to Fig. 15c-3 from the specification.

Appropriate correction is required.

### ***Allowable Subject Matter***

4. Claims 2-31 would be allowable if the claim objections and Double Patenting rejections, set forth in this Office action, are overcome.

5. The following is a statement of reasons for the indication of allowable subject matter:

The present invention has been deemed allowable for its unique manner of conducting negotiations between human users, including **"the analysis of terms**

**comprising understanding the purpose of the terms, formatting the terms according to the purpose**, and placing them into user supplied context” and the “automated negotiations engine further recognizing any changes in the terms and storing in the storage space the terms each terminal proposes, and recognizing the terminal to which the proposed terms are being sent as the indicated terminal, and sending terms to the indicated terminal, **the automated negotiations engine indicating any changes in the terms** until a set of terms is acted upon in a final manner” (recited in independent claims 2 and 17). The limitation “**the analysis of terms comprising understanding the purpose of the terms, formatting the terms according to the purpose**” has been interpreted to reflect the fact that when a user changes one of the negotiation terms, the negotiations engine does not just merely forward redline corrections, but it processes the change to decide to which category of terms the change correlates.

Silverman et al. (U.S. Patent No. 5,924,082) teach an interactive negotiations system between at least two human users, where the users may communicate with one another through a structured dialog; however, they fail to anticipate or suggest a negotiations engine which itself can identify the types of changes being made. Silverman et al. maintain a transcript of the negotiations session, but its central computer system does not analyze the changes to classify them by their particular term categories.

Furthermore, regarding the limitation “**the automated negotiations engine indicating any changes in the terms,**” the Shirley et al. reference (U.S. Patent No.

5,692,206) has been cited to teach a contract generation system which allows for manual editing (e.g., redlining) of the document for customization purposes (Abstract). Unlike the Shirley et al. reference, the present invention obviates the need for manual editing, which can cause a messy presentation and be time-consuming, by implementing a negotiations engine which itself handles the recognition and indication of changes in terms to the negotiating parties.

Ordish (U.S. Patent No. 5,195,031) teaches a trading system for providing real time context sensitive trading messages based on conversation analysis; however, Ordish's invention only provides relevant prompts and alerts in response to inconsistencies in the trading conversation. Ordish does not disclose or suggest the claimed document recompilation based on the most updated terms of the contract being negotiated, including the analysis of terms which are then placed into a user supplied context.

The presently claimed invention is also deemed novel over Sloo (WO 97/04410) because Sloo merely performs a redlined mark-up of the submitted document changes. Sloo does not disclose or suggest the claimed automated document recompilation based on the most updated terms of the contract being negotiated, including the analysis of terms which are then placed into a user supplied context.

Similarly, the TRADE'ex software (disclosed in the articles "TRADE'ex Unveils Marketmaker Software for Creating Online Marketplace," "TradeAccess Sponsors First U.S. Trade Mission Web Site for Department of Commerce," "Trade'ex Readies Java-based MarketMaker," "TRADE'ex Connects the UK," "TRADE'ex Introduces E-

Commerce Software for Procurement, Distribution, Virtual E-Markets," "10 Who Dared to Be Different," "Pioneering Reseller Sites," and "TRADE'x Develops Java Compliant Electronic Commerce Solution for Creating Wholesale Markets Over the Internet") does not disclose or suggest the claimed automated document recompilation based on the most updated terms of the contract being negotiated, including the analysis of terms which are then placed into a user supplied context.

Please note that all of the pending claims in the present case are indicated as allowable subject matter for the same reasons found throughout the parent applications (U.S. Patent Nos. 6,338,050; 6,336,105; 6,332,135; and 6,141,653).

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 2 and 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 11, 21, 30, 41, and 48 of U.S. Patent No. 6,338,050. Although the conflicting claims are not identical,



they are not patentably distinct from each other because both sets of claims recite the same allowable subject matter. Unlike claims 1, 11, 21, 30, 41, and 48 of U.S. Patent No. 6,338,050, claims 2 and 17 of the present application recite the use of a process mining function to evaluate a process related to the negotiation. Official Notice is taken that the use of a process mining function to evaluate a process is old and well-known in the art. Process mining is useful in evaluating the effectiveness of processes. For this reason, one of ordinary skill in the art at the time of Applicant's invention would have found it obvious and been motivated to modify claims 1, 11, 21, 30, 41, and 48 of U.S. Patent No. 6,338,050 to yield claims 2 and 17 in the present application.

8. Claims 2 and 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 11, and 17 of U.S. Patent No. 6,336,105. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims recite the same allowable subject matter. Unlike claims 1, 6, 11, and 17 of U.S. Patent No. 6,336,105, claims 2 and 17 of the present application recite the use of a process mining function to evaluate a process related to the negotiation. Official Notice is taken that the use of a process mining function to evaluate a process is old and well-known in the art. Process mining is useful in evaluating the effectiveness of processes. For this reason, one of ordinary skill in the art at the time of Applicant's invention would have found it obvious and been motivated to modify claims 1, 6, 11, and 17 of U.S. Patent No. 6,336,105 to yield claims 2 and 17 in the present application.

9. Claims 2 and 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of U.S. Patent No. 6,332,135. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims recite the same allowable subject matter. Unlike claims 1 and 3 of U.S. Patent No. 6,332,135, claims 2 and 17 of the present application recite the use of a process mining function to evaluate a process related to the negotiation. Official Notice is taken that the use of a process mining function to evaluate a process is old and well-known in the art. Process mining is useful in evaluating the effectiveness of processes. For this reason, one of ordinary skill in the art at the time of Applicant's invention would have found it obvious and been motivated to modify claims 1 and 3 of U.S. Patent No. 6,332,135 to yield claims 2 and 17 in the present application.

10. Claims 2 and 17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 20, 39, and 49 of U.S. Patent No. 6,141,653. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims recite the same allowable subject matter. Unlike claims 1, 20, 39, and 49 of U.S. Patent No. 6,141,653, claims 2 and 17 recite the use of a process mining function to evaluate a process related to the negotiation. Official Notice is taken that the use of a process mining function to evaluate a process is old and well-known in the art. Process mining is useful in evaluating the effectiveness of processes. For this reason, one of ordinary skill in the

art at the time of Applicant's invention would have found it obvious and been motivated to modify claims 1, 20, 39, and 49 of U.S. Patent No. 6,141,653 to yield claims 2 and 17 in the present application.

11. Claims 2 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 and 16 of copending Application No. 09/702,049. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims recite the same allowable subject matter. Unlike claims 2 and 16 of copending Application No. 09/702,049, claims 2 and 17 recite the use of a process mining function to evaluate a process related to the negotiation. Official Notice is taken that the use of a process mining function to evaluate a process is old and well-known in the art. Process mining is useful in evaluating the effectiveness of processes. For this reason, one of ordinary skill in the art at the time of Applicant's invention would have found it obvious and been motivated to modify claims 2 and 16 of copending Application No. 09/702,049 to yield claims 2 and 17 in the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 2 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 6, 10, and 20 of copending Application No. 09/702,050. Although the conflicting claims are not

identical, they are not patentably distinct from each other because both sets of claims recite the same allowable subject matter. Unlike claims 2, 6, 10, and 20 of copending Application No. 09/702,050, claims 2 and 17 recite the use of a process mining function to evaluate a process related to the negotiation. Official Notice is taken that the use of a process mining function to evaluate a process is old and well-known in the art. Process mining is useful in evaluating the effectiveness of processes. For this reason, one of ordinary skill in the art at the time of Applicant's invention would have found it obvious and been motivated to modify claims 2, 6, 10, and 20 of copending Application No. 09/702,050 to yield claims 2 and 17 in the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 2 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 10, 18, and 22 of copending Application No. 09/702,062. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims recite the same allowable subject matter. Unlike claims 2, 10, 18, and 22 of copending Application No. 09/702,062, claims 2 and 17 recite the use of a process mining function to evaluate a process related to the negotiation. Official Notice is taken that the use of a process mining function to evaluate a process is old and well-known in the art. Process mining is useful in evaluating the effectiveness of processes. For this reason, one of ordinary skill in the art at the time of Applicant's invention would have found it obvious

and been motivated to modify claims 2, 10, 18, and 22 of copending Application No. 09/702,062 to yield claims 2 and 17 in the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. All prior art listed on the attached PTO Form 892 and not explicitly discussed above in the reasons for allowance are cited because they were also cited in the parent applications. Further, please note that the references that were also cited in the parent applications are marked with an asterisk ("\*") on the PTO Form 892; therefore, no copies of these references are being mailed to the Applicant since it is assumed that Applicant already has these references in their possession.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Application/Control Number: 09/702,128  
Art Unit: 3623

Page 13

Any response to this action should be mailed to:

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**(703)305-7687** [Official communications; including  
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**(703)746-7048** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7<sup>th</sup> floor receptionist.



Susanna M. Diaz  
Patent Examiner  
Art Unit 3623  
December 13, 2002